

**Application No. 10/624,213
Filed July 22, 2003
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Amendment to the Drawings

Attached is replacement sheet 10, amending Fig. 10 to correct typographical errors. More specifically, Block 116 has been corrected to read "Route message to TDMA GSM HLR in TDMA GSM comm network" as dictated by the corresponding description in the specification at paragraph [0036]. Block 110 has also been amended to insert the word "to".

Attachment: Replacement Sheet

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REMARKS

I. Introduction

The application has been carefully reviewed in light of the Office Action dated September 29, 2005. This communication is believed to be a full and complete response to that Office Action. Claims 1-13 were pending in the present application prior to entry of the present amendments. By the present Office Action claims 1-13 have been rejected.

By the present amendment, claims 8, and 10-13 have been amended. Claims 6, 7, and 9 have been canceled. No new claims have been added. Claims 1-5, and 13 also remain in the application, and upon entry of the present amendment, Claims 1-5, 8, and 10-13 are present.

Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

I. SUMMARY OF THE AMENDMENTS

In the Claims

Claims 6, 7, 9 and 11 have been canceled. Claims 8 and 10-12 have been amended to change dependency therefrom from canceled claims. Claim 13 has been amended to more appropriately characterize the role of an HLR in delivering a message.

In the Drawings

FIG. 10 has been amended to correct typographical errors. More specifically, Block 116 has been corrected to read "Route message to TDMA GSM HLR in TDMA GSM comm network" as dictated by the corresponding description in the specification at paragraph [0036]. Block 110 has also been amended to insert the word "to".

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II. CLAIM REJECTIONS

Under 35 U.S.C. § 102

Claims 6, 7, 9, and 11

The Examiner has rejected Claims 6, 7, 9, and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication No. 2003/0224811 to Jain et al ("Jain"). These claims have been canceled, so the rejections thereto are moot.

Claim 13

The Examiner has rejected Claim 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication No. 2003/0186676 to Ogman et al. ("Ogman"). We respectfully traverse.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP § 2131; *Verdegaal Bros. V. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987). *Ogman* fails to satisfy this requirement because it does not disclose all of the elements of the rejected claim, which has been amended only to correct the usage of the word "to" because the word "using" is more accurate.

More specifically, the cited figures 4 and 5 and text [0045-56], [0064], and [0086-93] fails to disclose receiving a message at a message service center as recited in Claim 13, disclosing instead "how an incoming call 523 to the common number...is routed first to primary MS 205, and then to secondary MS 103 when primary MS 205 does not respond." At [0088], beginning of paragraph. The cited portion of *Ogman* also fails to disclose routing the message to a GSM or TDMA HLR according to the Terminal Type of the terminating communications device disclosing instead that "incoming calls are always directed to TDMA MSC-G 413." At [0091]. The cited text further fails to disclose routing the message using global title translation for a MSISDN or a MSIN associated with the communications device, disclosing instead "utilizing a lookup table to map the common telephone number into a unique derivative number, and then recovering the inherent telephone number of the primary telephone by using another lookup table." At [0088], end of paragraph.

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At least for the foregoing reasons, Claim 13 is patentable over the disclosure of *Ogman* as originally filed. The Examiner is respectfully requested to enter the amendment and to withdraw the rejection thereto.

Under 35 U.S.C. § 103(a)

The Office Action rejected Claims 1-5, 8, 10, and 12 under 35 U.S.C. § 103(a). The Examiner has the burden of establishing a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. 103(a). The CAFC (and the CCPA before it) has repeatedly held that, absent some teaching or suggestion in a primary reference supporting a modification or combination of references, an arbitrary modification of the primary reference or combination of references is improper. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). Also, the Federal Circuit has held that it is improper to modify a reference in a way that destroys the intent, purpose, or function of the invention disclosed in the reference. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). For these reasons and others as discussed below, the Examiner has failed to make out a *prima facie* case of obviousness. Each of the Examiner's rejections will now be discussed in view of the above prevailing case law.

To establish *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See e.g., *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). See MPEP § 2142.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP § 2143.01; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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Claims 1-5

The Examiner has rejected Claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication No. 2002/0094811 to Bright et al ("Bright") in view of U.S. Patent No. 6,625,461 to Bertacchi ("Bertacchi"). The Examiner states that since **Bright** and **Bertacchi** are related to the method for providing SMS in different communication networks, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of **Bright** as taught by **Bertacchi**:

the serving mobile telecommunications node receives a physical address for the originating telecommunications node that is compatible with the second signaling system, which is used by the originating telecommunications node. Because the serving mobile telecommunications node uses the first signaling system, however, a physical destination address that is compatible with the first signaling system needs to be identified so that the serving mobile telecommunications node can communicate with the originating telecommunications node. The identified physical address is used by the serving mobile telecommunications node for transmitting subsequent cellular protocol messages to the serving telecommunications node via the first signaling system.

at col. 3, ll. 23-36.

Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

The cited references, when combined, fail to teach all of the limitations of the rejected claims. Furthermore, there is no teaching or suggestion that supports combining the references as proposed. It is settled that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant's disclosure."

Here, the Office Action alleges that **Bright** discloses a method comprising migrating a communications device to a GSM communications network, the communications device migrated from at least one of a TDMA communications network and a CDMA communications network. The Office Action erroneously states that **Bertacchi** discloses the remaining elements of independent Claim 1. However, **Bertacchi** is directed to delivering an SMS message where "the message center's signaling system is different than the signaling system used between the VMSC 20 and the HLR 24," and *not* to routing to a GSM SMSC an origination request for sending a message from a communications device migrated from a TDMA or CDMA network. See e.g., col. 5, ll. 28-30 and col. 7, ll. 42-45 (underlining added). In

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fact, the text cited in support of this rejection (col. 7, ll. 28-37; col. 4, l. 41 - col. 5, l. 10), merely explains known procedures and "current SMS standards" for identifying the message center 22 associated with the mobile station 10, based on the addressing information in the SMS message that identifies the intended destination of the SMS message, in order to forward the SMS message to the message center 22. *Bertacchi* does not teach or suggest associating this addressing information [the network address] to a signaling point code, as recited by Claim 1.

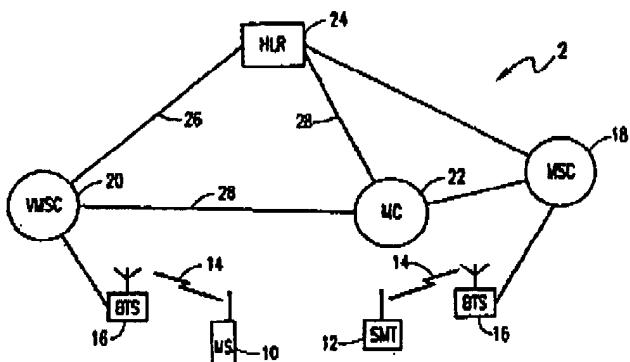


FIG. 1

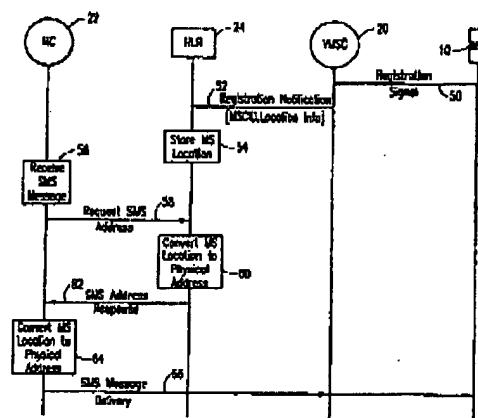


FIG. 3

More precisely, beginning at col. 7, l. 38, and with reference to its FIGs. 1 and 3 reproduced above, *Bertacchi* discloses providing the information identifying the location of the VMS 20 – this information is communicated from the VMS 20 to the HLR 24 as a logical address, and from the HLR 24 to the message center 22 as the physical address, which may include a signaling point code (SPC). Because "the VMS 20 uses a different signaling system (towards HLR) than the SMS message center 22...the HLR 24 converts the stored location information into an SMS address that is used by the SMS message center 22 at step 60." Col. 7, ll. 43-45 and ll. 63-65. In contrast, independent Claim 1 recites: receiving an origination request from the communications device, the origination request for sending a message from the communications device, the origination request comprising a network address; associating the network address to a SPC, the SPC identifying a message service center (SMSC) ...; and routing the origination request to the SMSC. Thus, it is clear that converting the address of an SMSC to a signaling point code (SPC) occurs, in the present application, at the point at which the SMSC must be identified (by the STP 26 - ¶ 18) in order for it to receive and/or store a message for delivery to its recipient. In contrast, *Bertacchi* discloses converting the address of

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a VMSC into a SPC (by the HLR 24) at the point at which a VMSC must be identified to deliver to its recipient a message that has already been received by the VMSC. This distinction is important in part because there is no indication that the sending device (short message terminal 12) in *Bertacchi* uses a different signaling system from that used by the SMSC (MC 22) to which the origination request or message is subsequently forwarded. Thus, the disclosure of *Bertacchi* does not teach or suggest the sending device 12 being migrated from a network that is different from the network of the SMSC.

With further regard to Claims 2 and 3, the Office Action states that *Bertacchi* further discloses updating the network address after migration of the communications device, wherein the network address identifies the message service center in the serving communications network. As demonstrated above, the address of *Bertacchi* identifies a VMSC and not a message service center. In contrast to the cited text (col. 4, ll. 27-40 and col. 10, ll. 58-67) explains the known process of continuously updating in the HLR with the identity of the VMSC serving a communications device located in its territory, Claims 2 and 3 of the present application recite updating the network address [that] identifies the message service center in the GSM network. As *Bertacchi* notes, "the physical address of the message center 22...is stored in the mobile station 10 for purposes of being able to send SMS messages." Col. 9, ll. 27-29.

Thus, because no combination of *Bertacchi* and *Bright* discloses, teaches, or suggests all of its limitations, independent Claim 1 is patentable over the cited references. Claims 2-5 depend from Claim 1, are patentable at least for the same reason, as well as in view of the additional arguments presented above.

Claims 8, 10, and 12

The Office Action rejected Claims 8, 10, and 12 as being unpatentable under 35 U.S.C. § 103(a) over *Jain* in view of *Bertacchi*. We traverse.

Claim 8 has been amended to be placed in independent form. As amended, Claim 8 recites, *inter alia*, routing to a signaling interface between the GSM communications network and the at least one of a TDMA communications network and a CDMA communications network a Signaling Point Code associated with the signaling interface. As the Examiner indicates, *Jain et al.* do not particularly show wherein the step of routing to the signaling interface comprises routing to a Signaling Point Code associated with the signaling

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interface. As follows from the arguments presented with respect to Claim 1, however, *Bertacchi* also fails to disclose this limitation, as this reference fails to disclose routing an origination request...comprising routing to a signaling interface. In fact, *Bertacchi* merely discloses routing the address of a VMSC via an HLR. As demonstrated above, *Bertacchi* does not disclose routing an origination request at all, nor does it associate a network address therein to an SPC, or wirelessly change the network address after migration of a subscription profile.

For at least the forgoing reasons, Claim 8 and its dependent claims 10 and 12 are patentable over the cited references.

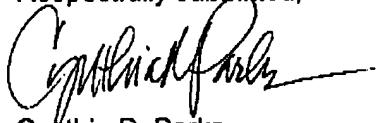
IV. CONCLUSION

For at least the above reasons, Applicant respectfully requests allowance of the claims pending in this case and issuance of a patent containing these claims in due course. Should Examiner Phan believe that a telephone conference would be useful to resolve any concerns and move this application to allowance, Examiner Phan is respectfully requested to contact the undersigned at the telephone number listed below. Otherwise, Applicant respectfully requests timely issuance of a Notice of Allowance for the present application.

V. EXTENSION OF TIME

It is respectfully requested that the period for response to the Office Action dated September 29, 2005 be extended one month, up to January 30, 2006 (January 29 falls on a Sunday). Form PTO-2038 authorizing payment in the amount of \$120 is enclosed.

Respectfully submitted,



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